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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/771,093

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Philip J. Simpson

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EXAMINER

ANDERSON, GREGORY A

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/771,093	<b>Applicant(s)</b> SIMPSON ET AL.	
	<b>Examiner</b> GREGORY A. ANDERSON	<b>Art Unit</b> 3773	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 January 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,4-11 and 14-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4-11 and 14-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>03032005</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of Species A1 and B1 in the reply filed on 28 January 2008 is acknowledged. However, upon further review, the Examiner deems the required species to be obvious expedients of one another and thus the restriction requirement sent 04 September 2007 has been withdrawn.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 4, 6, and 23-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 4: the phrase "traditional scalpel" renders the claim indefinite. The scope of the limitation is not distinct and cannot be determined by one of ordinary skill in the art.

Regarding claim 6: the phrase "principal axes" renders the claim indefinite. The scope of the limitation is not distinct and cannot be determined by one of ordinary skill in the art.

Regarding claims 23-26: It is unclear to the examiner whether a cutting depth being claimed or the configurations of the cutting element.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 4-11, 15, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Wurster et al. 5,591,186.

Regarding claim 1: Wurster discloses a system for rapid manipulation and cutting comprising: a housing 105, a first cutting element 29, a drive mechanism 30-32 adapted to be mounted at least partially within the housing and operatively connected to the first cutting element for imparting relative motion to the first cutting element as a combination of slicing and downward forces at the portion of the first cutting element which is adapted to contact the tissue; wherein the drive mechanism provides torque about the lateral axis of the first cutting element to import the slicing force, the torque causes the first cutting element to rotate eccentrically, and the drive mechanism causes the first cutting element to retract relative to the housing, such that the end of the housing proximal to the first cutting element acts as a protective guard to prevent accidental contact with the first cutting element (Fig. 8, Col. 4 ll. 55-67).

Regarding claim 4: Wurster further discloses the housing being substantially as a traditional scalpel: shaft 2 is tubular and pen-like.

Regarding claim 5: Wurster further discloses the housing being shaped as a hand piece (Fig. 20, 105 is handle).

Regarding claim 6: Wurster further discloses the drive mechanism imparting motion to the first cutting element along two of the three principal axes: drive mechanism causes first cutting element to rotate as well as move forwards and backwards (Col. 4 ll. 55-67).

Regarding claim 7: Wurster further discloses the housing being shaped for use as a tissue manipulator for blunt force dissection: tip 27 can be used to blunt force dissection.

Regarding claim 8: Wurster further discloses the cutting element being adapted for cutting tissue (Abstract ll. 1-11).

Regarding claim 9: Wurster further discloses the housing being adapted for use as a tissue probe: tip 27 can be used as a tissue probe.

Regarding claim 10: Wurster further discloses the drive mechanism advancing the first cutting element relative to the housing (Col. 4 ll. 55-67).

Regarding claim 11: the device of Wurster is capable of cutting man made materials.

Regarding claim 15: Wurster further discloses the drive mechanism including a pinion gear assembly (Fig. 8).

Regarding claim 20: Wurster further discloses the first cutting element comprising a plurality of blades (Fig. 8).

6. Claims 1 and 23-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Matthai et al. 5,101,564.

Regarding claim 1: Matthai et al. discloses a system for rapid manipulation and cutting comprising: a housing 11, a first cutting element 9, a drive mechanism 15 adapted to be mounted at least partially within the housing and operatively connected to the first cutting element for imparting relative motion to the first cutting element as a combination of slicing and downward forces at the portion of the first cutting element which is adapted to contact the tissue; wherein the drive mechanism provides torque about the lateral axis of the first cutting element to import the slicing force, the torque causes the first cutting element to rotate eccentrically, and the drive mechanism causes the first cutting element to retract relative to the housing, such that the end of the housing proximal to the first cutting element acts as a protective guard to prevent accidental contact with the first cutting element (Col. 7 ll. 30-38).

Regarding claims 23-26: Matthai et al. further discloses the cutting element controlling the depth of cut, rate of cut, ramp angle, and reaction load (Col. 2 l. 67, Col. 3 ll. 1-10).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wurster et al. in view of Moutafis et al. 6,451,017.

Wurster et al. discloses the invention essentially as claimed as discussed above.

However, Wurster et al. does not disclose the system including means for electrocautery.

Moutafis et al. discloses a cutting tool with means for electrocautery (Col. 4 ll. 2-11).

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the device of Wurster et al. with the means for electrocautery of Moutafis et al. in order to cauterize the tissue being cut as taught by Moutafis et al. (Col. 4 ll. 2-11).

9. Claims 16-19 and 21-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wurster et al. in view of substitution of known equivalents.

Regarding claims 16-19 and 21-22: Wurster discloses the invention as discussed in claim 1 above. Wurster further discloses the drive mechanism including a pinion gear assembly.

However, Wurster et al. does not disclose the drive mechanism including a bevel gear, a direct motor, or a crank arm drive, nor does Wurster et al. disclose the drive mechanism including hydraulic or pneumatic means.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the device of Wurster et al. by substituting any known drive mechanism for the pinion gear assembly of Wurster et al. since it has been held that

that reading a list and selecting a known compound to meet known requirements is no more ingenious than selecting the last piece to put in the last opening in a jig-saw puzzle: *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945).

Regarding claims 23-26: Wurster discloses the blades being detachable and thus replaceable (Col. 6 ll. 13-19) such that the blades can be disposed.

However, Wurster et al. does not disclose the depth of cut, ramp angle of the incision, and the rate of cut being variable based on the eccentricity of the first cutting element nor does Wurster et al. disclose the reaction load being based on the design of the first cutting element.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the device of Wurster et al. by varying the depth of cut, ramp angle, rate of cut, and reaction load in order to meet the specific needs of the user since it has been held that reading a list and selecting a known compound to meet known requirements is no more ingenious than selecting the last piece to put in the last opening in a jig-saw puzzle: *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945).

### **Conclusion**

**10.** The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Farr 4,950,277 discloses a device as in claim 1.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GREGORY A. ANDERSON whose telephone number is



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(571)270-3083. The examiner can normally be reached on Mon-Thurs 9:30am-3:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gregory A Anderson/

/(Jackie) Tan-Uyen T. Ho/  
Supervisory Patent Examiner, Art Unit 3773